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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,019	03/03/2005	Guillaume Sebire	879A.0030.U1(US)	3593
29683 7590 12/22/2008 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE, Suite 202 SHELTON, CT 06484-6212			EXAMINER BALAOING, ARIEL A	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/501,019	Applicant(s) SEBIRE ET AL.	
	Examiner ARIEL BALAOING	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

2. Applicant's arguments, see page 6 of remarks, filed 12/04/2004, with respect to the rejection(s) of claim(s) 9-15, and 18-25 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of DALSGAARD et al (WO 0016581).

Allowable Subject Matter

3. The indicated allowability of claim 14 is withdrawn in view of the newly discovered reference(s) to DALSGAARD et al (WO 0016581). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by DALSGAARD et al (WO 00/16581).

Regarding claim 10, DALSGAARD discloses an apparatus (abstract; apparatus such as GPRS base stations) comprising: a controller having two or modes (GPRS service or lower level service), where the controller wirelessly communicates to at least one wireless terminal [**mobile station**] an availability of at least one of the two or more

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service modes through the use of a system information 3 message [**SI3 or PSI3**] of a global system for mobile communications system [**GSM system**] transferred on a first broadcast control channel [**PBCCH or BCCH**], wherein an availability of one of the two or more service modes is indicated through a single spare bit in the first message (abstract; page 1, line 27-30; page 4, lines 15-30, page 8, line 14-26; determined service of neighbor cells using at least one-bit information of PSI 3 or SI3), and, if it is indicated that one of the two or more service modes is available, then a second broadcast control channel through which service information of the one of the two or more service modes is to be broadcast is described (page 5, line 4-33; page 6, line 1-34; page 12, line 10-15; MS needs information describing second broadcast control channel (PBCCH) from SI13 message).

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. DALSGAARD further discloses wherein the first broadcast control channel is a broadcast control channel of the global system for mobile communications system (page 1, line 27-30; page 4, lines 15-30; BCCH or PBCCH).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 12, 14 rejected under 35 U.S.C. 103(a) as being unpatentable over DALSGAARD et al (WO 00/16581).

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. DALSGAARD further discloses wherein the single

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spare bit is a spare bit in the system information 3 (page 4, lines 15-30; page 8, lines 14-27; DALSGAARD discloses that support information can be determined using a single bit within a system information 3). DALSGAARD discloses the claimed invention except for wherein the spare bit is in the rest octets. It would have been obvious to a person of ordinary skill in the art to provide the single spare bit in the system information 3 rest octets since the Examiner takes Office Notice that choosing any bit within the system information 3 to provide service support information would have been a design choice, since DALSGAARD states that the system information 3 message is used to determine service capabilities by a mobile terminal, and therefore the choice of location for a spare bit would have no effect on determining support information. Furthermore, it has been held that rearrangement of parts (in this case location of a spare bit) would require only routine skill in the art. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, DALSGAARD does not expressly disclose wherein the single spare bit represents the only previously undedicated bit in the system information 3 message. It would have been obvious to a person of ordinary skill in the art to provide the single spare bit in the only previously undedicated bit since the Examiner takes Office Notice that choosing any bit within the system information 3 to provide service support information would have been a design choice, since DALSGAARD states that the system information 3 message is used to determine service capabilities by a mobile terminal, and therefore the choice of location for a spare

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bit would have no effect on determining support information. Furthermore, it has been held that rearrangement of parts (in this case location of a spare bit) would require only routine skill in the art. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

7. Claims 9, 13, 15, 18, 19, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DALSGAARD et al (WO 00/16581) in view of MILDH et al (US 2002/0193139 A1).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. DALSGAARD further discloses wherein the single spare bit is a spare bit in the system information 3 (page 4, lines 15-30; page 8, lines 14-27; DALSGAARD discloses that support information can be determined using a single bit within a system information 3). However, the combination of DALSGAARD and MILDH discloses the claimed invention except for wherein the spare bit is in the rest octets. It would have been obvious to a person of ordinary skill in the art to provide the single spare bit in the system information 3 rest octets since the Examiner takes Office Notice that choosing any bit within the system information 3 to provide service support information would have been a design choice, since DALSGAARD states that the system information 3 message is used to determine service capabilities by a mobile terminal, and therefore the choice of location for a spare bit would have no effect on determining support information. Furthermore, it has been held that rearrangement of parts (in this case location of a spare bit) would require only routine skill in the art. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, DALSGAARD does not expressly disclose wherein the single spare bit is an lu support indicator. In the same field of endeavor, MILDH discloses wherein a spare bit is an lu support indicator (Figure 2; paragraph 16, 21; Figure 2 shows an example of System information bits, also supported on page 7 of the provisional application). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DALSGAARD to include the teachings of MILDH, since MILDH states that such a modification would allow a determination of support services within a mixed network.

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. DALSGAARD further discloses wherein the apparatus comprises a base station controller in a global system for mobile communications radio access network (page 3, lines 3-7; further including GPRS packet services). However, DALSGAARD does not expressly discloses wherein the global system for mobile communications is a global system for mobile communications/enhanced data rates for global evolution (i.e. GSM/EDGE and GERAN cell). In the same field of endeavor, MILDH discloses wherein a global system for mobile communications is a global system for mobile communications/enhanced data rates for global evolution (paragraph 6, 11, 14; also see page 2 section 1.4 of the provisional application). Therefore it would have been obvious to a person of ordinary skill in the art at the time the inventions was made to modify BALSGAARD to include the teachings of MILDH, since the use of GSM/EDGE protocol would enable

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DALSGAARD to incorporate more advance packet services within the GSM network disclosed.

Regarding claim 18, DALSGAARD discloses a method comprising: in a cell under control of a global system for mobile communications (GSM) radio access network, a radio resource management system of the radio access network comprising a first and a second message [**system information messages**], which messages are transferred on a first broadcast control channel [**BCCH PBCCH**], and which first message has at least one spare bit, wherein the first message is system information 3 of global system for mobile communications system, using said at least one spare bit for broadcasting of a possibility to use a service by indicating whether said cell supports said service (abstract; page 1, line 27-30; page 4, lines 15-30, page 8, line 14-26; determined service of neighbor cells using at least one-bit information of PSI 3 or SI3), and in a favorable case in which the global system for mobile communications radio access network controlled cell is determined to support the service, describing a second broadcast control channel in the second message to at least mobile stations (page 5, line 4-33; page 6, line 1-34; page 12, line 10-15; MS needs information describing second broadcast control channel (PBCCH) from SI13 message)), and broadcasting the service information for mobile stations on the second broadcast control channel (page 9, line 6-24; page 12, line 3-24; mobile stations tunes to selected control channel to obtain service). However, DALSGAARD does not expressly disclose. However, DALSGAARD does not expressly discloses wherein the global system for mobile communications is a global system for mobile communications/enhanced data rates for

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global evolution (i.e. GSM/EDGE and GERAN cell) using Iu; and wherein the indicated service is universal mobile telecommunications service. In the same field of endeavor, MILDH discloses wherein a global system for mobile communications is a global system for mobile communications/enhanced data rates for global evolution (i.e. GSM/EDGE and GERAN cell) using Iu mobile stations (Figure 2; paragraph 6, 11, 14, 16, 21; Figure 2 shows an example of System information bits, also supported on page 7 of the provisional application); and wherein the indicated service is universal mobile telecommunications service (paragraph 3, 6, 11, and 14). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify DALSGAARD to include the teachings of MILDH, since MILDH states that such a modification would allow a determination of support services within a mixed network.

Regarding claim 19, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. DALSGAARD further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (page 8, line 14-26; col. 12, line 3-13; system information message describes PBCCH of favorable system).

Regarding claim 25, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD and MILDH further discloses said cell being barred against UMTS operation through Iu interface by indicating with information that UMTS service is not supported in said cell (MILDH – Figure 2; paragraph 11, 15-19).

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8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DALSGAARD et al (WO 00/16581) in view of MILDH et al (US 2002/0193139 A1) and further in view of ETSI 3GPP 04.18 v 9.0.

Regarding claim 20, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD and MILDH further discloses the radio access network supporting the UMTS-service and not supporting a GPRS service, wherein said first message further comprises an lu indicator field (MILDH - paragraph 6, 15-18; Figure 2). However, the combination of DALSGAARD and MILDH does not expressly disclose wherein said second message is System Information 13alt of the GSM system and is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a second message is System Information 13 of the GSM system and is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of DALSGAARD and MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 21, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD and MILDH further discloses the second channel being available also to the GPRS service (MILDH – Figure 2paragraph 6, 15-18). However the combination of DALSGAARD and MILDH

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does not disclose wherein said second message is System Information 13 of the GSM system. ETSI 3GPP 04.18 v 9.0 discloses wherein a second message is System Information 13 of the GSM system (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of DALSGAARD and MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 22, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD and MILDH further discloses the second channel being available also to the GPRS service (paragraph 6, 15-18). However the combination of DALSGAARD and MILDH does not disclose wherein said message System Information 13 is legible only to Iu mobile stations and Gb mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein said message System Information 13 is legible only to Iu mobile stations and Gb mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of DALSGAARD and MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

Regarding claim 23, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD and MILDH further discloses the second channel being not available to the GPRS service (paragraph 6, 15-18). However the combination of DALSGAARD and MILDH does not disclose wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations. ETSI 3GPP 04.18 v 9.0 discloses wherein a description of the second channel in the message System Information 13 is legible only to lu mobile stations (page 148, section 9.143a; page 244-245, section 10.5.2.26a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of DALSGAARD and MILDH to include the use of System Information 13, as taught by ETSI 3GPP 04.18 v9.0, since System Information 13 is a well known and conventional protocol used in GSM system to provide information related to GPRS within a cell (see page 148).

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over DALSGAARD et al (WO 00/16581) in view of MILDH et al (US 2002/0193139 A1) and ETSI 3GPP 04.18 v 9.0 as applied to claim 3 above, and further in view of RAITH (US 5,930,706).

Regarding claim 24, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. The combination of DALSGAARD, MILDH, and ETSI 3GPP 04.18 v 9.0 further discloses said lu to transfer the second message (MILDGH - paragraph 6, 11, 15-18). However, the combination of DALSGAARD, MILDH, and ETSI 3GPP 04.18 v 9.0 does not expressly disclose an indicator field

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indicating whether normal BCCH or extended BCCH is used to transfer a message.

RAITH discloses an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message (paragraph 21, line 22-57). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of DALSGAARD, MILDH, and ETSI 3GPP 04.18 v 9.0 to include an indicator field indicating whether normal BCCH or extended BCCH is used to transfer a message as taught by RAITH, since RAITH teaches that such a modification would allow a system to transmit information at various rates depending on importance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARIEL BALAOING whose telephone number is (571)272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Ariel Balaoing/
Examiner, Art Unit 2617

/A. B./
Examiner, Art Unit 2617